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HOLLAND & KNIGHT LLP 10 ST. JAMES AVENUE BOSTON, MA 02116			EXAMINER MURDOUGH, JOSHUA A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

Acknowledgements

1. This action is responsive to Applicants' "Request to Withdraw Finality of Office Action dated February 9, 2009" (herein "Request to Withdraw Finality") received 7 April 2009.
2. This advisory action has been assigned paper number 20090428 for reference purposes only.

Findings of Fact

3. A first action non-final was sent on 27 September 2007.
4. Applicants responded with an affidavit under rule 131 on 27 March 2008 ("First Affidavit").
5. A final action was mailed on 13 June 2008 because the First Affidavit was unsuccessful at disqualifying the intended reference.
6. An Information Disclosure Statement ("IDS") was received 28 July 2008.
7. No submission other than the IDS was received after the final action was mailed until the Request for Continued Examination ("RCE") on 13 November 2008 ("2008 RCE")
8. Included with the RCE on 13 November 2008 was another affidavit under rule 131 ("Second Affidavit").
9. The Second Affidavit was also found to be unsuccessful at disqualifying the reference.
10. On 9 February 2009 a first action final was mailed in response to the 2008 RCE.
11. All amendments (if any) submitted after final have been entered. As of today's date, no after final amendment has been denied entry.

12. As of today, there are not outstanding IDSs to be considered.

Authorities

13. MPEP 706.07(b) (Rev 6, Sept 2007) expressly states:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

>The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114.<

...

However, it would not be proper to make final a first Office action in a continuing or substitute application >or an RCE< where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

14. MPEP § 706.07(b).

Conclusions of Law

15. MPEP § 706.07(b) sets forth the guidelines for when a first action final is proper. The MPEP and their relation to the current application are as follows:

- a. The application is an RCE.

- b. All claims of this application:
 - i. are drawn to the same invention claimed in the earlier application; and
 - ii. would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

The only amendment to the claims was to traverse a 112 2nd rejection. The rejections set forth in the 9 February 2009 action are the same grounds using the same art as the previous action.

16. Therefore, the Examiner has complied with § 706.07(b). Because the Examiner has met his burden under MPEP § 706.07(b), the subsequent office action was made final.

17. Also, the forth paragraph of MPEP § 706.07(b) establishes exceptions to the guidelines, which are:

- c. *The action is a continuing, substitute, or RCE;* The application is an RCE.
- d. *the application contains material which was presented in the earlier application after final or closing of prosecution;* As noted above, the only after final submission was and IDS.
- e. *the material was denied entry because of one of the following reasons:*
 - iii. *new issues were raised that required further consideration and/or search;*
or
 - iv. *the issue of new matter was raised.*

18. No material was denied entry. Furthermore, neither an IDS nor an affidavit may be denied entry for the reasons listed.
19. Therefore, none of the exceptions are met. Therefore, the first action may still be made final.
20. The application of these paragraphs will be discussed in more detail in response to Applicants detailed arguments.

Response to Arguments

21. Applicant's arguments filed 7 April 2009 have been fully considered but they are not persuasive.
22. Applicants argue:
23. "The issue in this petition is whether entry of a new 131 affidavit raises new issues within the application such that entry of a final action after an RCE is improper" (Request to Withdraw Finality, Page 2, Paragraph 1).
24. Examiner's response:
25. The raising of new issues within the application is not the standard to determine if a first action final is proper. See the sections of MPEP 706.07 (b) above.
26. Applicants argue:

27. “[T]he M.P.E.P. states an exception: finality is improper where an applicant raises ‘new issues’ that require ‘further consideration’” (Request to Withdraw Finality, Page 3, partial paragraph).

28. Examiner's response:

29. The Examiner respectfully disagrees. Applicants have neglected some of the criteria set forth by the MPEP. The MPEP does not say that simply raising “new issues that require further consideration” is sufficient to require a first action non-final.

30. First the Examiner notes that Applicants have not alleged that the conditions from the first cited paragraph have not been complied with (points a, b, b.i, and b.ii) in this argument. This argument is directed towards the exceptions in the second quoted paragraph. The relevant passage of which being “that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration.” Applicants never presented the new 131 affidavit in the earlier application. Therefore, the Examiner could not have denied its entry because of new issues being raised that require further consideration. Moreover, requiring further consideration is not one of the reasons an affidavit can be denied entry. The proper reasons for not entering an affidavit after final are noted in sections 8 and 9 of the attached Advisory Action Sheet (PTOL-303; Rev. 08-06). The Examiner will not discuss these in more detail, at this time, as they have not been applied and are not germane to the present issue.

31. Applicants argue:

32. "The Applicants' November 13 affidavit raised new issues that required further consideration" (Request to Withdraw Finality, Page 3, Paragraph 1).

33. Examiner's response:

34. The Examiner agrees. The Examiner considered the newly submitted Second Affidavit. However, as discussed above, new consideration is not the test for determining whether a first action final is proper.

35. Applicants argue:

36. "However, on February 9, the Examiner found new grounds and raised new issues for rejecting the application and finding the November 13 affidavit insufficient" (Request to Withdraw Finality, Page 3, Paragraph 1).

37. Examiner's response:

38. Rejections are made under the statutes 35 U.S.C. §§ 101, 102, 103, and 112. Affidavits are allowed and controlled by the regulations, most notably 37 C.F.R. §§ 1.131 and 1.132.

Objections sometimes arise when dealing with the regulations, however, a rejection under the regulations cannot be made.

39. The only change in the rejections in the 9 February 2009 action was the withdrawal of a rejection of claim 11 under 35 U.S.C. § 112 2nd Paragraph. Had this change been made after a non-final action, the Examiner could have properly gone final. The criteria for a change in grounds that allows a first action final set out by the MPEP and quoted by Applicants is "would

have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.” The art was not changed and no new grounds of rejection were asserted.

40. Applicants argue:

41. “The Examiner did not repeat any of the grounds used to reject the June 13 affidavit” (Request to Withdraw Finality, Page 3, Paragraph 1).

42. Examiner's response:

43. The Examiner agrees. The Examiner never rejected the June 13 affidavit. Therefore, no grounds of rejection of the affidavit could possibly be repeated.

44. Applicants argue:

45. “The fact that the Examiner raised new grounds for his findings, and the fact that the old grounds were not applied to the November 13 affidavit, shows that the November 13 affidavit raised new issues that required further consideration” (Request to Withdraw Finality, Page 3, Paragraph 1).

46. Examiner's response:

47. The Examiner has not disputed the fact that consideration of the November 13 affidavit was required. However, the Examiner again asserts that new consideration is not the test for

when a first action final can be issued. As noted above, the Examiner has not raised any new grounds of rejection. Thus the final rejection.

48. Applicants argue:

49. “Therefore, the finality of the February 9 action should be withdrawn because the M.P.E.P. states that finality is improper if a response filed after an RCE raises new issues that require further consideration” (Request to Withdraw Finality, Page 3, Paragraph 1).

50. Examiner's response:

51. The Examiner respectfully disagrees. Applicants have mischaracterized what is stated by the MPEP. The MPEP states finality would be improper if the RCE “contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration” not that “finality is improper if a response filed after an RCE raises new issues that require further consideration” as alleged by Applicants. Again, the Examiner notes, that further consideration is not a proper reason to deny entry of an affidavit.

52. Applicants argue:

53. “[T]he Examiner argued that if new issues are to preclude finality, then those new issues must be issues relating to the claims. But the M.P.E.P does not state this limitation” (Request to Withdraw Finality, Page 3, Paragraph 2).

54. Examiner's response:

55. The MPEP, as quoted by Applicants, states “all *claims* of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application” (emphasis added). This requires that the grounds of the rejections to the claims that do not use the art of record and that could not have properly been made final in the previous application. The specific recitation of “all claims” shows that the claims and the associated rejections are the key to determining when a first action final is proper.

56. Applicants argue:

57. “[A] newly filed 131 affidavit does relate to the claims” (Request to Withdraw Finality, Page 3, Paragraph 2).

58. Examiner's response:

59. An effective 131 affidavit would relate to the rejections of the claims, inasmuch as it requires new grounds of rejection using art not of record. However, the current, ineffective 131 affidavit does not change the grounds of rejection for the claims. Therefore, a proper affidavit would prevent a first action from being made final. However, an ineffective one, does not as the rejections of the claims are not changed as required by the MPEP to preclude a first action final.

Conclusion

60. For the reasons set forth above, the Examiner does not find Applicants' arguments towards the impropriety of the finality of the previous action persuasive. Therefore, the **finality is maintained**. Applicants' period for response is established as set forth in section 1(b) of the attached Advisory Action Sheet (PTOL-303).

61. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

62. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

63. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/ANDREW J. FISCHER/
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